

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) MONOHALOGENOVINYL VITAMIN
ANTONIO BUXADÉ VIÑAS et al) D DERIVATIVE COMPOUNDS
)
Serial No. 10/579,594) Confirmation No. 3552
)
Filed May 17, 2006) Group Art Unit 1625
) Examiner Taylor V. Oh

DECLARATION OF SANTIAGO JORDÁ PETERSEN

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Santiago Jordá Petersen, being duly sworn, hereby states and declares as follows:

1. I am an industrial engineer with a specialization in mechanical technology, a Spanish industrial property attorney (Spanish Qualifying Examination passed in 2003), and a European patent attorney (European Qualifying Examination passed in 2006). I am working in industrial property matters since 1997, and I am the responsible of the Patent Department in Curell Suñol S.L.P, which handles the drafting and prosecuting of patents for Spanish applicants in Spain and/or Europe and the corresponding extensions in foreign countries. Since 2007 I am also tutor in courses preparing for the European Qualifying Examination.

2. The Spanish Patent Office has no rules specifying precise language which must be used in order to include information from a cited document as part of the disclosure of a patent application.

3. The Spanish Patent Office frequently, however, assumes the criteria used by the European Patent Office as being its own criteria.

4. The European Patent Office in its "Guidelines for Examination in the European Patent Office" indicates that the expression "herein incorporated by reference" should not be used and, thus, states that such language must be deleted (Guidelines C-II.4.19, 4th paragraph).

5. Because of the EPO Guidelines, it is usual practice to intentionally not include "incorporated by reference" language in European Patent applications. Since Spanish patent applications are typically drafted in such a way that they could be extended later to the EPO without modifying the text, such language is also typically and intentionally not used in Spanish patent applications.

6. The EPO requires that "the features [that have to be incorporated be] precisely defined and identifiable within the total technical information in the reference document." In the practice, this has meant that the EPO usually does not consider the citation of a whole document to be sufficient to incorporate a part of the document. Rather, the EPO requires specifying the portions of a document which are really relevant.

7. No issue regarding the need to include the hydroxyl protective groups in the Spanish or corresponding EPO application (EP 1 688 409) was raised during the prosecution of those applications. However, it is my opinion that both the Spanish Patent Office and the European Patent Office would determine that the reference to the TW Green book in the patent applications filed in those Offices would be sufficient under their practices to support incorporation of the list of hydroxyl protective groups from the TW Green book which Applicant has attempted to add to this corresponding U.S. application by amendment.

8. In my opinion, reference in each and every one of the corresponding patent application has clearly and sufficiently been made to the list of the hydroxyl protective groups cited in the TW Green book.

9. To have used the "magic words" ("incorporated by reference") in this application as originally have filed would have required using phraseology which is not only not required in the country of original filing, but is disapproved. To require in this later filed U.S. patent application that support for the disclosure required use of specific phraseology which would have been ineffective in the priority filings places Applicant in an unfair and untenable position.

10. It is my understanding that U.S. practice, while strongly favoring the specific "incorporated by reference" phraseology, does not require that language. It is further my understanding that what is required by U.S. practice is that the disclosure clearly conveys the intent to incorporate the material by reference. The language as originally filed in the priority documents (both the Spanish application and the PCT application) clearly conveys that intent under Spanish (and EPO) practice. The language used in the U.S. application is a direct English language translation of that

Spanish disclosure, and thus in my opinion should be recognized as similarly conveying the intent to incorporate the material by reference (specifically, the list of hydroxyl protective groups added by Corrected Amendment "B").

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

13.7.2010
Date

SJP
Santiago Jordá Petersen